



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,063	08/27/2001	Michael J. Briskin	1855.1070-004	3846

21005 7590 05/12/2003

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.
530 VIRGINIA ROAD
P.O. BOX 9133
CONCORD, MA 01742-9133

EXAMINER

ROARK, JESSICA H

ART UNIT

PAPER NUMBER

1644

DATE MAILED: 05/12/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/940,063

Applicant(s)

BRISKIN ET AL.

Examiner

Jessica H. Roark

Art Unit

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2001 and 09 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16,21-47,51,53,58,60,67,69,77,80,84,88-94 and 97-112 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) See Continuation Sheet are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Continuation of Disposition of Claims: Claims subject to restriction and/or election requirement are 16,21-47,51,53,58,60,67,69,77,80,84,88-94 and 97-112.

Art Unit: 1644

DETAILED ACTION

1. Applicant's preliminary amendments, filed 8/27/01 and 1/9/02 (Paper Nos. 5 and 8) are acknowledged. Claims 1-15, 17-20, 48-50, 52, 54-57, 59, 61-66, 68, 70-76, 78-79, 81-83, 85-87 and 95-96 have been cancelled.
Claims 97-112 have been added.
Claims 24, 27-33, 35, 43-46, 84, 88 and 108 have been amended.
Claims 16, 21-47, 51, 53, 58, 60, 67, 69, 77, 80, 84, 88-94 and 97-112 are pending.

Sequence Compliance

2. The instant application is in sequence compliance for patent applications containing nucleotide sequence and/or amino acid sequence disclosures.

Restriction Requirement

3. The Restriction Groups below correspond to the Groups set forth in parent application USSN 09/449,437.
4. Restriction to one of the following inventions is required under 35 U.S.C. § 121:
 - I. *All claims cancelled*, drawn in USSN 09/449,437 to a method of detecting and/or identifying an agent which binds to or antagonizes mammalian BONZO, classified in Class 435, subclass 7.1.
 - II. Claim 16, drawn to a method of detecting BONZO in a biological sample, classified in Class 436, subclass 63.
 - III. Claims 21-46, 84, 88 and 97-112, drawn to an antibody or antigen-binding fragment thereof which binds BONZO and inhibits ligand binding, kits comprising said antibody, and a cell producing said antibody, classified in Class 530, subclass 388.22; and Class 435, subclasses 326 and 810.
 - IV. Claims 47, 53 and 60, drawn to a method of treating an inflammatory disease, inhibiting a cellular response, or inhibiting BONZO function by administering an antagonist/antibody which binds BONZO and inhibits ligand binding, classified in Class 424, subclass 143.1.
 - V. Claims 51 and 58, drawn to a method of treating an inflammatory disease, or inhibiting a cellular response, by administering an antibody which binds SExCkine and inhibits receptor binding, classified in Class 424, subclass 145.1.
 - VI. Claims 60, 67, drawn to a method of promoting BONZO function or recruiting BONZO+ cells to a location by administering SExCkine, Classified in Class 424, subclass 85.1.

Art Unit: 1644

VII. Claim 69, drawn to a targeting molecule comprising SExCkine and an antibody which binds a cell surface molecule, classified in Class 424, subclass 192.1.

VIII. Claim 69, drawn to a targeting molecule comprising an antibody to BONZO and an antibody which binds a cell surface molecule, classified in Class 424, subclass 136.1.

IX. Claim 77, drawn to a method of effectuating interaction of a BONZO+ cell with a target by administering a targeting molecule comprising SExCkine and an antibody which binds a cell surface molecule, classified in Class 424, subclass 192.1.

X. Claim 77, drawn to a method of effectuating interaction of a BONZO+ cell with a target by administering a targeting molecule comprising an antibody to BONZO and an antibody which binds a cell surface molecule, classified in Class 424, subclass 136.1.

XI. Claim 80, drawn to a method of isolating cells enriched in cytotoxic effector cells using an antibody to BONZO, classified in Class 435, subclass 325.

XII. Claim 94, drawn to SExCkine, classified in Class 530, subclass 351.

XIII. Claim 89, drawn to a kit comprising an antibody to SExCkine, classified in Class 435, subclass 810.

XIV. Claim 90, drawn to a nucleic acid encoding the 4A11 antibody, classified in Class 536, subclass 23.53.

XV. Claim 91, drawn to a nucleic acid encoding the 7A2 antibody, classified in Class 536, subclass 23.53.

XVI. Claim 92, drawn to a nucleic acid encoding the 7F3 antibody, classified in Class 536, subclass 23.53.

XVII. Claim 93, drawn to a nucleic acid encoding the SExCkine:antibody fusion protein targeting molecule, classified in Class 536, subclass 23.4.

5. Groups III/VII/VIII/XII/XIII/XIV/XV/XVI/XVII are different products. Antibodies, polypeptides, fusion proteins, bispecific antibodies, and nucleic acids differ with respect to their structures and physicochemical properties; therefore each product is patentably distinct.

6. Groups (XIV/XV/XVI and III) and (XVII and VII) respectively are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product, the protein can be made using an amino acid synthesizer.

7. Groups I/II/IV/V/VI/IX/X/XI are different methods. Each method differs from the others with respect to ingredients, method steps, or endpoints; therefore, each method is patentably distinct.

Art Unit: 1644

8. Groups (III and II/IV/XI), (VII and IX), (VIII and X), (XII and I/VI), and (XIII and V), respectively are related as product and process of using. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)).

In the instant case:

The antibodies of Groups III and XIII can be used for affinity purification, in addition to the methods of treating and detecting recited.

The method of effectuating interaction with a BONZO+ cell of can be accomplished with either the fusion protein of Group VII or the bispecific antibody of Group VIII.

The chemokine SExCkine can be used in to produce antibodies, in addition to the methods of detecting the receptor and promoting the function of the receptor as recited.

9. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter, restriction for examination purposes as indicated is proper.

10. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

11. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica Roark whose telephone number is (703) 605-1209. The examiner can normally be reached Monday through Friday from 8:00 AM to 4:30 PM. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.

Jessica Roark, Ph.D.
Patent Examiner
Technology Center 1600
May 6, 2003

PHILLIP GAMBEL
PHILLIP GAMBEL, PH.D.
PRIMARY EXAMINER
TECH CENTER 1600
5/9/03